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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,150	03/23/2000	Kimihiro Yamashita	KIK01 P-319	1126

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EXAMINER

GUPTA, ANISH

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 06/03/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/533,150

Applicant(s)

YAMASHITA, KIMIHIRO

Examiner

Anish Gupta

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The amendment filed, 2-25-03, is hereby acknowledged. Claims 4-21 were canceled by the amendment. Claims 1-3 were amended. Claims 1-3 are pending in this Application.

All of the rejections cited in the previous office action are now hereby withdrawn and New Grounds of rejection follows below.

### NEW GROUNDS FOR REJECTIONS

#### *Specification*

2. The disclosure is objected to because of the following informalities:

The instant disclosure makes reference to claims in many instances. For example, on page 10, the specification states, making reference to the cement material, "as described in claim 11." These references are improper, especially since the claims have been canceled.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims have been amended to recite the limitation "contacting the adsorbed microorganism with one or more agents selected from growth promoting agents, growth inhibiting agents, activating agents and deactivating agents." This limitation in claim 1, lack both literal and inherent support and is new matter.

#### **Lack of literal support**

In reviewing the Application the specification does not provide any literal support for the active step of "contacting the adsorbed microorganism with one or more agents selected from growth promoting agents, growth inhibiting agents, activating agents and deactivating agents." The words growth promoting agents, growth inhibiting agents, activating agents and deactivating agents do not appear literally in the specification. Nor does the specification provide guidance to a step of "contact" of the adsorbed microorganism to specific agents. The MPEP advises, in section 2163.06 and echoed in 2172.01, that for "newly added or amended claims, applicants should show support in the original disclosure for the new or amended claims." In the amending response, Applicants did not furnish this information and thus it could not be ascertained where Applicants believe is location for the literal support.

#### **Lack of Inherent Support**

The MPEP also states support for amendment of claims can also be achieved via inherent disclosure of the amendment. See MPEP 2163. In reviewing the specification, one could not get readily ascertain the inherent support for the new limitation. The specification does not define what growth promoting agents, growth inhibiting agents, activating agents and deactivating agents

can be. Nor does the specification exemplify a single agent that would be readily ascertainable, to one of ordinary skill in the art that, such an agent is known to be a growth promoting agents, growth inhibiting agents, activating agents or deactivating agents. Further, the claims, as amended, implies that the agents result in the control of growth, inhibition of growth, activation or deactivation of the microorganism. However, the specification states "in accordance with the present invention, organisms such as cells, bacteria, viruses, fungi, can be grown, decreased activated or inactivated at the N-surface or the P-surface of the ceramic which is formed by the treatment of polarization." (See page 10 of the specification). The specification goes on to state that "[t]he N-surface or the P-surface of the ceramic treated by polarization can affect cells and tissues of organisms so that cells of the organisms, immunization cells and lymph corpuscles are grown, cell tissue and nerve cells are activated and various tissues and cells are regenerated and grown." These two sentences imply that it is the polarization of the ceramic material that results in the growth, activation, or deactivation of cells and not the addition of an exogenous agent. Thus, for these reasons, one could not readily conclude that addition of an exogenous agent in the method is inherently taught or disclosed in the instant application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states growth promoting agents, growth inhibiting agents, activating agents and deactivating agents. It is unclear what agents constitute a growth promoting agent, growth inhibiting agent, activating agent, and deactivating agent. The disclosure neither defines nor exemplifies, using specific agents, any of these limitations. Thus, the claim is indefinite.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (703) 308-4001. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can normally be reached on (703)306-3220. The fax phone number of this group is (703) 308-4242.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
Anish Gupta

  
**BRENDA BRUMBACK**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**